

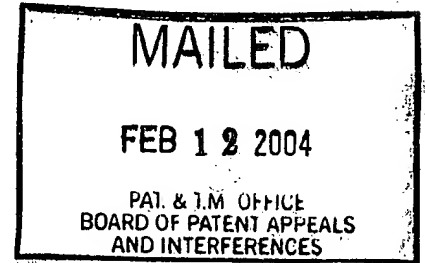
**UNITED STATES PATENT AND TRADEMARK OFFICE**

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

*Ex parte* RETO SCHOB

Appeal No. 2002-2171  
Application No. 09/127,644

ON BRIEF



Before HAIRSTON, BARRY, and LEVY, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

**REMAND OF APPEAL**

A patent examiner rejected claims 1, 3-8, 10, 14, and 17-21. The appellant appeals therefrom under 35 U.S.C. § 134(a). We remand.

In an *ex parte* appeal, "the Board is basically a board of review — we review . . . rejections made by patent examiners." *Ex parte Gambogi*, 62 USPQ2d 1209, 1211 (Bd.Pat.App. & Int. 2001). Here, after considering the record, we are persuaded that "[t]he appeal is manifestly not ready for a decision on the merits." *Ex parte Braeken*, 54

USPQ2d 1110, 1112 (Bd.Pat.App. & Int. 1999). Our opinion addresses the following deficiencies in the order in which they appear in the examiner's answer:

- incomplete list of references
- rejection of canceled claim
- omission of translations
- omission of reference
- lack of specificity.

#### A. INCOMPLETE LIST OF REFERENCES

An examiner's answer is "required to include . . . [a] listing of the references of record relied on, and, in the case of nonpatent references, the relevant page or pages." M.P.E.P. § 1208 (8<sup>th</sup> ed., rev. 1 Feb. 2003). Here, although the examiner lists some of the references of record under the heading "Prior Art of Record," (Examiner's Answer at 3), the list is incomplete. Specifically, it omits the following references on which he relies:

- "Machino," (Examiner's Answer at 5)
- "German Patent No. 945,183," (*id.* at 5-6)
- "Schoeb." (*id.* at 6-7.)

Therefore, a complete listing of **all** the references on which the examiner relies is required. The listing must include the relevant page or pages of any such references that are not patents.

#### B. REJECTION OF CANCELED CLAIM

The examiner states, "[c]laims 1, 4, 8, 9, 10, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nichols and Lyman." (Examiner's Answer at 3.) As noted by the appellant, however, claim 9 has been canceled. (Appeal Br. at 2.) Therefore, correction of the statement is required.

#### C. OMISSION OF TRANSLATIONS

"Citation of an abstract without citation and reliance on the underlying scientific document itself is generally inappropriate where both the abstract and the underlying document are prior art." *Ex parte Jones*, 62 USPQ2d 1206, 1208 (Bd.Pat.App. & Int. 2001). "[A] proper examination under 37 CFR § 1.104 should be based on the underlying documents and translations, where needed. Accordingly, the preferred practice is for the examiner to cite and rely on the underlying document." *Id.* "To determine whether both the abstract and the underlying document are prior art, a copy of the underlying document must be obtained and analyzed. If the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection." M.P.E.P. § 706.02.

Here, the examiner relies on Machino *inter alia* to reject claims 6 and 7, (Examiner's Answer at 5), and German Patent No. 945,183 *inter alia* to reject claims 17-19. (*Id.* at 5-6.) Although the application file includes an abstract of Japanese Patent Application No. 59-113,316 by Toshiaki Machino, a translation of the Application is omitted. Similarly, although the record includes a copy of the German Patent, a translation thereof is omitted.

"The review authorized by 35 U.S.C. Section 134 is not a process whereby the examiner . . . invite[s] the [B]oard to examine the application and resolve patentability in the first instance." *Braeken*, 54 USPQ2d at 1112. To the contrary, "obtaining translations is the responsibility of the examiner." *Jones*, 62 USPQ2d at 1209. Therefore, translations of both the Japanese Application and the German Patent are needed for our review of the associated rejections.<sup>1</sup>

#### D. OMISSION OF REFERENCE

Copies of cited references are to be "placed in the application file . . . during the prosecution." M.P.E.P. § 707.05(a). A copy of each reference on which the examiner relies is required for our review. Here, although the examiner relies on "Schoeb" *inter*

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<sup>1</sup>Besides our review, a review by the examiner and the appellant of the translations also "may supply additional relevant evidence. . . ." *Jones*, 62 USPQ2d at 1209.

*alia* to reject claims 20 and 21, (Examiner's Answer at 6-7), no copy of the reference appears in the application file. Therefore, such a copy is needed for our review of the associated rejections.

#### E. LACK OF SPECIFICITY

"For each rejection under 35 U.S.C. 103, the examiner's answer . . . shall . . . state the ground of rejection and **point out where each of the specific limitations recited in the rejected claims is found in the prior art relied upon in the rejection. . . .**" M.P.E.P. § 1208 (emphasis added). "[W]here there are questions as to how limitations in the claims correspond to features in the prior art . . . , the examiner shall compare at least one of the rejected claims feature by feature with the prior art relied on in the rejection. The comparison shall align the language of the claim side-by-side with a reference to the specific page, line number, drawing reference number, and quotation from the prior art, as appropriate." *Id.*

Here, although the examiner relies on Schoeb *inter alia* to reject claims 20 and 21, (Examiner's Answer at 6-7), he declines to point out where the specific limitations recited in these claims is found Schoeb. Instead, he generally alleges that "Schoeb teaches the use of motors in biological liquids and in a bio-reactor." (*Id.*) For our review, we need the examiner to point out where the specific limitations to which he

refers are found in the reference. In other words, a mapping of each of these claimed features to lines in the written description or to elements in the figures of the Schoeb is needed.<sup>2</sup>

### CONCLUSION

We "decline to substitute speculation as to the rejection for the greater certainty which should come from the [examiner] in a more definite [explanation] of the grounds of rejections." *Gambogi*, 62 USPQ2d at 1212. Instead, we remand the application to the examiner to prepare a substitute examiner's answer correcting the aforementioned deficiencies. The substitute answer should be self-contained with respect to all rejections and arguments. No prior examiner's answer or Office action should be referenced or incorporated therein. Similarly, any supplemental brief submitted by the appellant should be self-contained with respect to all arguments. No prior brief should be referenced or incorporated therein.

Because it is being remanded for further action, the application is a "special" application. M.P.E.P. § 708.01(D). Accordingly, it requires immediate action.


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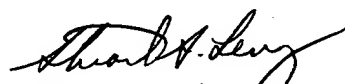
<sup>2</sup>The appeal of the rejection evidences that "there are questions as to how limitations in the claims correspond to features in the prior art. . . ." M.P.E.P. § 1208.

Furthermore, the Board should be informed promptly of any action affecting status of the appeal (e.g., abandonment, issue, reopening prosecution).

REMANDED

  
KENNETH W. HAIRSTON  
Administrative Patent Judge

  
LANCE LEONARD BARRY  
Administrative Patent Judge

  
STUART S. LEVY  
Administrative Patent Judge

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